



PATENT  
Customer No. 22,852  
Attorney Docket No. 05725.0987-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Daniela GIACCHETTI et al. ) Group Art Unit: 3629  
Application No.: 10/024,621 ) Examiner: Igor N. BORISSOV  
Filed: December 21, 2001 ) Confirmation No.: 3961  
For: SYSTEMS AND METHODS FOR )  
PROVIDING BEAUTY GUIDANCE )

**Attention: Mail Stop Appeal Brief-Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Pursuant to 37 C.F.R. § 41.41, Appellants submit this Reply Brief in response to the Examiner's Answer dated October 21, 2005.

If any additional fees are required in connection with the filing of this Reply Brief, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

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## **I. STATUS OF CLAIMS**

Claims 1-69 have been finally rejected and are subject to this appeal.

## II. GROUNDS OF REJECTION

In the Examiner's Answer dated October 21, 2005, the Examiner **withdrew** the rejections of claims 1-55 and 67-69 under 35 U.S.C. § 101. Accordingly, the remaining grounds of rejection to be reviewed on appeal are listed below:

- A. Claims 1-69 stand rejected under 35 U.S.C. § 112, ¶ 1 as based on an allegedly non-enabling disclosure.
- B. Claims 1, 4-6, 9-15, 17-20, 24-27, 29-36, 43-47, 51-53, 56, 59-62, and 64-67 stand rejected under 35 U.S.C. § 102(e) based on PCT International Publication No. WO 01/18674 ("Maloney").
- C. Claims 2, 3, 7, 8, 16, 28, 37-42, 54, 55, 57, 58, 63, 68, and 69 stand rejected under 35 U.S.C. § 103(a) based on *Maloney* in view of U.S. Patent Application Publication No. 2003/0078854 ("Shim").
- D. Claims 21-23 and 48-50 stand rejected under 35 U.S.C. § 103(a) based on *Maloney* in view of *Shim*, U.S. Patent No. 3,936,957 ("Nordbye"), and U.S. Patent No. 3,968,661 ("Williams").

### III. ARGUMENT IN REPLY

#### A. Rejection Under 35 U.S.C. § 112, ¶ 1

##### a. The Examiner has not shown why a skilled artisan considering the specification, could not make and use the claimed invention.

The Examiner alleges that “the specification does not provide any indication of functionality connecting the method steps of ‘receiving astrological horoscope sign of a consumer’ and ‘recommending to the consumer a beauty product.’” *Examiner’s Answer*, p. 12. Appellants note, however, that the specification provides specific examples (see e.g., pp. 13-18 and 23-24) explaining how beauty guidance is provided using profile information and a subject’s birth-related classification, such as astrological information. Further, the specification describes an exemplary operating environment in which the claimed invention can be implemented (see e.g., Fig. 5 and accompanying description in specification). And, contrary to the Examiner’s allegation, the specification clearly discloses how astrological signs and beauty products can be related within the context of the claims (see e.g., pp. 13-18 and 23-24). The specification also makes clear how astrological signs or other birth-related information can be used to provide beauty product recommendations (see e.g., pp 15-16). Hence, a skilled artisan, considering the teachings of the specification, could in fact make and use the claimed invention. Accordingly, the Examiner has not shown why a skilled artisan considering the specification, could not make and use the claimed invention.

**B. Rejection Under 35 U.S.C. § 102**

**a. The Examiner provides no evidence demonstrating that “life stage” anticipates or suggests a “birth-related classification.”**

The Examiner alleges that the “life stage” disclosed at page 7 of *Maloney* is the same as the “birth-related classification” recited in claims 1, 36, 59, and 67. See *Examiner’s Answer*, p. 13. However, the Examiner provides no evidence demonstrating that a “life stage” anticipates or necessarily suggests a “birth-related classification.” For instance, nowhere in the disclosure of *Maloney* does it mention any connection between a life stage and a birth-related classification. Indeed, the disclosure of *Maloney* does not make any mention of a birth-related classification at all. *Maloney* merely describes life stage as one example of **psychological** data. *Maloney*, p. 7. Hence, life stage refers to the periods of a life with psychological impact, such as starting high school, going to college, marriage, and retirement. This is not the same as a birth-related classification, such as a subject’s astrological horoscope sign. Accordingly, *Maloney’s* disclosure regarding a “life stage” does not anticipate “providing guidance for the subject, the guidance . . . being a function of the profile information and [a] . . . birth-related classification,” as recited in claim 1.

**C. Rejection Under 35 U.S.C. § 103**

**a. The Examiner has provided no valid evidence demonstrating that the alleged motivation to combine was found in the prior art.**

The Examiner alleges that there is a motivation to combine (1) *Maloney* and *Shim*, or (2) *Maloney*, *Shim*, *Nordbye*, and *Williams*. See *Examiner’s Answer*, pp. 13 and 15. Specifically, the Examiner alleges that the motivation to combine would be to

“advantageously enhance the effectiveness of [the] advertising of said beauty-related products, thereby potentially [increasing] revenue.” *Id.* M.P.E.P. § 2143 specifies, however, that the requirements for establishing *prima facie* obviousness must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001). The Examiner has provided no valid evidence demonstrating the alleged motivation to combine was found in the prior art. For instance, the Examiner attempts to rely on paragraphs [0195], [0200], and [0201] of *Shim* as the basis for the motivation to combine. *Examiner’s Answer*, p. 13. However, paragraph [0195] merely discloses “[a] user answering the above questions as follows: ‘Type-A blood’, ‘Scorpio’, ‘yellow’, ‘dog’, can be classified as having or exercising a high level of restraint.” *Shim*, p. 9. Further, paragraph [0200] merely discloses

[t]he prior art does not have the basis for analyzing the user type. And then when [sic] the advertisement provider sells the noble metal ring, the advertisement provider advertises to all user types including the “the stability type”, the “restraint type” and the “sentiment type”. A greater advertisement cost is generated and the advertisement effect is not displayed.

*Id.*, p. 10.

Finally, paragraph [0201] merely discloses “[t]he present invention improves the decreasing effect of the whole advertisement cost and advertisement effect because the present invention displays the advertisement only to suitable users according to character type.” *Id.*

None of paragraphs [0195], [0200], and [0201] of *Shim* describes or mentions any motivation to combine the cited references (1) to provide guidance for a subject, the guidance being a function of the profile information and a birth-related classification, (2)

to recommend at least one beauty product to a subject as a function of a birth-related classification, (3) to provide to a user of a second website a recommendation to use a beauty product offered for sale through a first website, the recommendation being a function of a birth-related classification of the user, (4) to provide guidance for the subject, the guidance at least including beauty advice related to at least one beauty product and being a function of the subject's astrological horoscope sign, and (5) to dispense guidance including beauty advice, the guidance being a function of a birth-related classification of the subject, as recited in independent claims 1, 36, 53, 55, 56, 59, and 67, respectively.

Accordingly, one must conclude the alleged motivation to combine was not reached based on facts gleaned from the cited references, but instead, was improperly reconstructed from the teachings of Appellants' specification. Hence, the conclusions in the final Office Action and Examiner's Answer constitute improper hindsight reasoning.

#### **IV. CONCLUSION**

For the above reasons and the reasons stated in Appellant's Appeal Brief of August 1, 2005, pending claims 1-69 are allowable, and reversal of the Examiner's rejections is respectfully requested.

If any additional fees are required in connection with the filing of this Reply Brief, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 21, 2005

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